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Docket 47765-C/JPW/AJM/AHM

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Collin J. Weber et al.
Serial No. : 09/049,865 Examiner: M. Davis
Filing Date : March 27, 1998 Group Art Unit: 1642
For : METHOD OF INHIBITING IMMUNE SYSTEM DESTRUCTION
OF TRANSPLANTED VIABLE CELLS

1185 Avenue of the Americas
New York, New York 10036
November 1, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

**PETITION UNDER 37 C.F.R. §1.181 TO WITHDRAW HOLDING OF
ABANDONMENT AND CONTINGENT PETITION TO REVIVE
UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 C.F.R.
§1.137(b) WITH ACCOMPANYING CONTINUED PROSECUTION APPLICATION**

This is a Petition under 37 C.F.R. §1.181 to withdraw the holding of abandonment set forth in the Notice of Abandonment issued May 7, 2002 in connection with the above-identified application. A copy of the May 7, 2002 Notice is attached hereto as **Exhibit A**.

REMARKS

Notice of Abandonment and Related Facts

April 10, 2001 Office Action

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OFFICE OF PETITIONS

On April 10, 2001, the U.S. Patent and Trademark Office issued an Office Action in connection with the subject application. A copy of the Office Action is annexed hereto as **Exhibit B**. On

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page 6 of the Office Action, it was stated that the Office Action was made final. However, on the page entitled "Office Action Summary", the box entitled "This action is FINAL" was not marked, indicating to one relying on the information on that page that the Office Action was non-final.

Statement Regarding Docketing of April 10, 2001 Office Action

The undersigned hereby states that the individual(s) in the undersigned's office having responsibility for docketing Patent Office-related actions and their due dates ("docket clerk(s)") entered into the undersigned's docketing system the July 10, 2001 due date for responding to the April 10, 2001 Office Action. A copy of this docket record showing this entry is annexed hereto as **Exhibit C**. Specifically, this docket record shows the entry "3 month response due" under the column entitled "Action", and the entry "10JL2001" under the column "Action Due Date."

The undersigned notes that in the annexed docket record, no entry under "Action" or "Action Due Date" appears in connection with the filing of a Notice of Appeal. The undersigned hereby states that were an entry regarding a Notice of Appeal made by the docket clerk(s), that entry would have appeared in the annexed docket record. The undersigned maintains that the absence of any entry regarding a Notice of Appeal was caused by ~~the docket clerk(s)'~~ reasonable conclusion that the April 10, 2001 Office Action was non-final, based on the absence of a mark in the box entitled "This Action is FINAL" on the Office Action Summary page.

July 9, 2001 Amendment

On July 9, 2001, applicants filed a response to the April 10,

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2001 Office Action, indicating on their response that the Office Action was a final Office Action.

Subsequent to filing the July 9, 2001 Amendment, applicants did not file a Notice of Appeal or an extension of time. The undersigned hereby states that this non-filing was due to the absence in the docket record of any due date for filing a Notice of Appeal.

January 15, 2002 Advisory Action

On January 15, 2002, the U.S. Patent and Trademark Office issued an Advisory Action in connection with the subject application. A copy of the Advisory Action is annexed hereto as **Exhibit D**. The Advisory Action was sent to the Patent Department at Bristol-Myers Squibb Company (BMS) instead of to the undersigned's office to which it should have been sent. The Advisory Action was then forwarded by BMS to the undersigned's office, and received by the undersigned's office on February 19, 2002. The undersigned hereby states that the Advisory Action was inadvertently misplaced within the undersigned's office subsequent to receipt.

In addition, the undersigned notes that the annexed docket record shows the entry "Examiner Issued Adv. Action" under the column entitled "Action", and the entry "15JA2002" under the column "~~Taken Date.~~". ~~The undersigned also notes that in the~~ annexed docket record, no entry under the column entitled "Action Due Date" appears in connection with the January 15, 2002 Advisory Action. The undersigned hereby states that were an entry regarding a due date for taking further action (e.g. filing a Notice of Appeal or Appeal Brief) in connection with the Advisory Action made by the docket clerk(s), that entry would have appeared in the annexed docket record. The undersigned maintains that the absence of any entry regarding a

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due date for taking further action in connection with the Advisory Action was caused by the docket clerk(s)' reasonable conclusion that the January 15, 2002 Advisory Action was issued in error based either on (a) the recorded non-final status of the April 10, 2001 Office Action or (b) in the alternative, the non-filing of a Notice of Appeal within six months of the Office Action's issuance.

On May 1, 2002, the undersigned spoke by telephone with Examiner Minh Tam, the Examiner assigned to the subject application, concerning the January 15, 2002 Advisory Action. During the telephone conference, the Examiner stated to the undersigned that the April 10, 2001 Office Action was final, that neither a Notice of Appeal nor request for extension of time was timely filed, that the subject application should therefore have been deemed abandoned, and that the Advisory Action was thus issued in error. The Examiner also stated that according to the U.S. Patent and Trademark Office's internal records, the application was not yet deemed abandoned, and that the Examiner would issue a communication in due course clarifying the status of the application.

May 7, 2002 Notice of Abandonment

On May 7, 2002, the U.S. Patent and Trademark Office issued a Notice of Abandonment in connection with the subject application.

The May 7, 2002 Notice states that the subject application is abandoned in view of the applicants' failure to timely reply to the April 10, 2001 Office Action, for the reason that no timely filed Notice of Appeal or request for extension of time was received by the U.S. Patent and Trademark Office.

The May 7, 2002 Notice was sent to BMS instead of the

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undersigned's office to which it should have been sent by the U.S. Patent and Trademark Office. On August 16, 2002, BMS forwarded the May 7, 2002 Notice to the undersigned by facsimile. A copy of an August 16, 2002 letter from Christopher Klein, Esq. of BMS to John P. White, Esq. of the undersigned's office is annexed hereto as **Exhibit E**, as evidence of the date on which the May 7, 2002 Notice was sent to the undersigned's office.

Action Requested

Petition to Withdraw Holding of Abandonment

In view of the foregoing, applicants hereby (a) petition for withdrawal of the holding of abandonment of the subject application, and (b) request that the April 10, 2001 Office Action be deemed a non-final Office Action, thereby making applicants' July 9, 2001 Amendment a complete response thereto.

Alternatively, in the event that the April 10, 2001 Office Action can not be deemed a non-final Office Action, but applicants' Petition for withdrawal of the holding of abandonment is granted, applicants request entry of the Continued Prosecution Application ("CPA"), annexed hereto as **Exhibit F**, under 37 C.F.R. §1.53(d) in connection with the subject application. The fee for filing a Continued Prosecution Application is SEVEN-HUNDRED AND FIFTY-EIGHT DOLLARS (\$758.00) (which amount includes the base filing fee and additional claim fee). Authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Contingent Petition to Revive Unintentionally Abandoned Application

Should this Petition to Withdraw Holding of Abandonment not be

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granted, applicants hereby petition to revive the subject unintentionally abandoned application under 37 C.F.R. §1.137(b).

A petition under 37 C.F.R. §1.137(b) must be accompanied by:

- (1) the required reply, unless it has been previously submitted;
- (2) the petition fee set forth in 37 C.F.R. §1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and
- (4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to 37 C.F.R. §1.137(c) for a utility application filed before June 8, 1995.

Should this Petition to Revive be granted, applicants request entry of the CPA annexed hereto as **Exhibit F** under 37 C.F.R. §1.53(d) in connection with the subject application. Authorization is hereby given to charge the \$758.00 CPA filing fee to Deposit Account No. 03-3125.

The fee for filing a Petition under 37 C.F.R. §1.137(b) is ONE THOUSAND TWO HUNDRED AND FORTY DOLLARS (\$1,240.00). Authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Pursuant to 37 C.F.R. §1.137(b)(3), the undersigned hereby states that, for the reasons set forth above in connection with the Petition to Withdraw Holding of Abandonment, the entire delay in filing the required reply from the original due date for reply until the filing of this Petition pursuant to 37 C.F.R. §1.137(b) was unintentional.

Because the subject application was filed after June 8, 1995,

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no terminal disclaimer is required under 37 C.F.R §1.137(c).


Summary

Applicants respectfully request grant of this Petition to Withdraw Holding of Abandonment and, in the event such Petition is not granted, applicants respectfully request grant of the contingent Petition to Revive Unintentionally Abandoned Application.

If a telephone interview would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the contingent fees for the CPA filing and Petition under 37 C.F.R. §1.137(b), is deemed necessary in connection with the filing of this Petition to Withdraw Holding of Abandonment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
Tel. No. (212) 278-0400
